

38. (New) A method of forming picture data for a game device for displaying, as a picture, an object moving in accordance with developments of a game, said method comprising:

reading a present position of said object; and

drawing a trace mark in length within a predetermined range from said present position according to the movements of said object, said trace mark having a plurality of portions; and

extinguishing said trace mark from a rear section of each portion by making said rear section of each portion lighter in color with lapse of time. --

#### REMARKS

By the present amendment, Applicants cancel claim 16 without prejudice or disclaimer of the subject matter therein, amend claims 15, 17-21, and 23 to more appropriately define the present invention, and add new claims 28-38 to protect additional aspects of the present invention. Claims 15, 17-23, and 28-38 are currently pending in the application.

In the Office Action dated September 18, 2002, the Examiner rejected pending claims 15, 17-18, and 22 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,329,991 to Fukuda et al. ("Fukuda"), and rejected claims 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Fukuda in view of EP 0367405 to Willan ("Willan"). The Examiner indicated claims 19 and 23 contain allowable subject matter,

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

but were objected to because they depend from rejected base claims. Applicants wish to thank the Examiner for the indication of allowable subject matter.

Applicants submit that the statutory basis of 102(b) upon which the Examiner relies upon for the rejection of claims 15, 17-18, and 22 is incorrect. Under 35 U.S.C. 119, the present application claims the benefit of priority of Japanese Application No. 8-312459, filed on November 22, 1996. In order for the Fukuda patent to be valid 102(b) prior art, it would have to have issued at least one year prior to the priority date of November 22, 1996. However, Fukuda issued on December 11, 2001. Applicants respectfully request that the Examiner provide for the record the proper statutory basis regarding the rejection of these claims, if any exists, in another non-final Office Action. However, Applicants herewith respond to an anticipation rejection in order to materially advance the prosecution of this application.

Applicants respectfully traverse the §102 rejection of pending claims 15, 17-18 and 22 because the Examiner failed to establish a *prima facie* case of anticipation. In order to properly anticipate Applicants' claimed invention under 35 U.S.C. §102, each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. §2131 (8th Ed., Aug. 2001), quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. §2131 (8th ed. 2001), p. 2100-69.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Fukuda discloses data processing method and apparatus which can input and output trace data. Specifically, Fukuda discloses an input/output electronic apparatus having a display with a digitizer; when a trace is input by a trace input pen, a resulting trace output is formed on the display (col. 2, lines 26-31; Fig. 2). As multiple traces are entered into the digitizer, Fukuda discloses that differences between new and old traces can be recognized in order to clarify the display and avoid confusing the user (col. 3, lines 49-52). Fukuda discloses that by changing the appearance of the entire trace, the user can distinguish between traces entered at different times (col. 3, lines 54-61, Fig. 9; col. 4, lines 24-33, Fig. 11). In one embodiment, Fukuda discloses changing the brightness of the entire trace over time (col. 3, lines 42-44, Fig. 7, STEP 54). In another embodiment, Fukuda discloses varying the thickness of an entire trace over time (col. 4, lines 18-22, Fig. 10, STEP 84).

Accordingly, Fukuda fails to disclose a combination of elements, including at least a "trace mark drawing means for drawing a trace mark in length within a predetermined range from said present position according to a movement of said object, said trace mark having a plurality of portions, and for extinguishing said trace mark from a rear section of each portion by making said rear section of each portion lighter in color with lapse of time," (emphasis added) as recited by claim 15.

Accordingly, Applicants respectfully request the Examiner to withdraw the anticipation rejection of claim 15. Claims 17, 18, and 22 depend from claim 15 and are allowable for at least the reasons described above for allowable claim 15.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Applicants respectfully traverse the §103(a) rejection of claims 20 and 21 to Fukuda in view of Willan because the Examiner failed to establish a *prima facie* case of obviousness under §103(a). In order to maintain a valid §103(a) rejection, each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. §2143.03 (8<sup>th</sup> ed. 2001).) Second, there must be some suggestion or motivation, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, not in Applicant’s disclosure.” (M.P.E.P. § 2143 (8<sup>th</sup> ed. 2001).)

Claims 20 and 21 depend from claim 15, and thus include all of the recitations thereof. As addressed in the argument provided above, Fukuda fails to teach or suggest all of the features recited in claim 15.

In this respect, Willan fails to cure the deficiencies of Fukuda. Willan teaches a computer graphics system having an input device and a means for detecting changes in the position of the input device relative to a surface (col. 1, lines 41-44). Willan further teaches a means for determining at least one derivative with respect to time of the input device position, and controlling characteristics of displayed patterns based upon the derivative (col. 1, lines 47-51).

Because Fukuda and Willan, either separately or in combination, fail to teach or a combination of elements including, at least, a “trace mark drawing means for drawing a

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

trace mark in length within a predetermined range from said present position according to a movement of said object, said trace mark having a plurality of portions, and for extinguishing said trace mark from a rear section of each portion by making said rear section of each portion lighter in color with lapse of time," (emphasis added) as required by claims 20 and 21.

Furthermore, Applicants disagree with the motivation alleged by the Examiner for modifying Fukuda with the teachings of Willan. The Examiner purports that Willan's teachings may be used in order to make the trace look more "realistic." However, Fukuda merely teaches creating a visual track which outlines that path of an input pen's (13) path over a digitizer (12) (col. 2, lines 39-42, Fig. 3), hence Fukuda's use of the term "trace." Fukuda does not teach providing graphics output which represents images simulating reality, hence, there is no need to make Fukuda's traces appear more realistic. Additionally, there would be no reasonable expectation of success to incorporate the teachings of Willan into Fukuda since both fail to teach or suggest all of the elements included in claims 20 and 21.

Accordingly, Applicants respectfully request the Examiner to withdraw the § 103(a) rejection of claims 20 and 21.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER <sup>LLP</sup>

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

Please grant any extension of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRET & DUNNER, L.L.P.

Dated: March 18, 2003

By: Richard V. Burgujian Reg 24,014  
for Reg. No. 31,744

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

**APPENDIX**

15. (Amended) A game device for displaying, as a picture, an object moving in accordance with developments of a game, said game device comprising:

means for reading a present position of said object; and

trace mark drawing means for drawing a trace mark in length within a predetermined range from said present position according to a movement of said object, said trace mark having a plurality of portions, and for extinguishing [a bottom position of] said trace mark from a rear section of each portion by making [gradually] said rear section of each portion lighter in color with lapse of time.

17. (Amended) [A]The game device according to claim [16]15, wherein a[the] trace pattern assigned to said [each] plurality of portions is previously stored as a pattern having different density in [a] storage means.

18. (Amended) [A]The game device according to claim [16]15 wherein said trace pattern assigned to said [each] plurality of portions is obtained by changing the transparency of a basic trace pattern.

19. (Amended) [A]The game device according to any one of claims 15, 17, or 18, wherein said trace mark drawing means extends only [the]a top position of said trace mark when the present position of said object is located less than a predetermined value apart from the top position of [the]a drawn trace mark, and said trace mark

drawing means moves, by said predetermined value, said trace mark in its entirety toward the present position of said object when the present position of said object is located not less than said predetermined value apart from the top position of the drawn trace mark.

20. (Amended) [A]The game device according to any one of claims 15, 17, or 18, wherein said trace mark drawing means adjusts [the]a timing to extinguish the drawn trace according to a moving speed of said object.

21. (Amended) [A]The game device according to any one of claims 15, 17, or 18, wherein said trace mark drawing means does not extinguish the drawn trace mark when said object stands still, while said trace mark drawing means extinguishes the drawn trace mark at a speed according to a moving speed of said object when said object is moving.

23. (Amended) [A]The game device according to claim [16]15, wherein said trace mark drawing means [has]comprises:

a cyclic register for retaining positions of respective portions of [a]the trace mark, which consists of said pluralityof portions, in a plurality of storage regions which respectively relate to the respective portions of the trace mark; and

mark top position indicating means for indicating a storage region of the cyclic register, which corresponds to [the]a top position of [a]the trace mark.